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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1953

No. 424

WESTINGHOUSE ELECTRIC CORPORATION,
a corporation,
*Petitioner*
v.
BULLDOG ELECTRIC PRODUCTS COMPANY,
a corporation,
*Respondent*

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT

## BRIEF FOR RESPONDENT IN OPPOSITION

ARTHUR W. DICKEY,
S. EUGENE BYCHINSKY,
7—141 General Motors Building,
Detroit 2, Michigan,
*Counsel for Respondent.*

Interstate Brief & Record Co., 642 Beaubien St., Detroit 26, Michigan

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*To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:*

### I. OPINIONS BELOW

The District Court opinion is reported at 106 Fed. Supp. 819, and that of the Court of Appeals at 206 F. (2d) 574.

## II. JURISDICTION

Jurisdictional requisites are adequately stated in the petition.

## III. QUESTIONS PRESENTED

The petition states the formal questions presented, namely, the questions of validity and infringement of the three United States Letters Patent. In Hodgkins Patent No. 2,073,103, the claims in issue specified in the petition are only 9 of 44 claims contained in the patent; in Jennings Patent No. 2,190,517, the claims in issue specified in the petition are only 15 of 35 claims contained in the patent; and in Swingle Patent No. 2,329,362, the claims in issue specified in the petition are only 16 of the 84 claims contained in the patent. The remaining claims of each patent were not in issue.

If the petition were granted, respondent, in addition to defenses against alleged infringement and validity, would urge also the defense of unclean hands arising out of misuse of the patents by petitioner.

## IV. STATEMENT

The concurring decisions of the Courts below are based essentially upon determination of questions of fact. Substantial evidence in support appears in the record, particularly the BullDog Appendix, Volume 1, in which pages 29-136 contain testimony respecting the Hodgkins Patent No. 2,073,103; pages 137-259 respecting the Jennings Patent No. 2,190,517; and pages 260-358 respecting the Swingle Patent No. 2,329,362. The petition makes no charge that

the determinations of fact by the Courts below are not supported by substantial evidence in the record.

It was found (District Court findings, Westinghouse Appendix, pp. 246-249) that:

In general, circuit breakers of the kind which are the subject of the patents in suit and the parts that go to make them up—such as terminals, contacts, fixed and movable, movable contact— or switch—arms, handles and springs, and various additional mechanical elements for moving the contact or switch arm to open and closed position, and bimetallic and electro-magnetic devices for providing automatic opening of the movable contact or switch arms—were old and known prior to the patents in suit. (BullDog Appendix, Volume II, prior art patents, particularly British Patent to Holmes No. 17,888, page 423; United States Patents to Von Hoorn No. 1,786,796, page 369; Krantz No. 1,726,233, page 361; Laganke No. 1,789,183, page 447; Laganke No. 2,025,872, page 487; Getchell No. 1,761,117, page 480; No. 1,759,395, page 473; and No. 1,886,477, page 438; Jennings No. 1,794,901, page 530; and Taylor No. 2,018,904, page 493.)

No commercial use has been made of the circuit breaker constructions shown in the drawings and described in the specifications of the Hodgkins patent No. 2,073,103, the Jennings patent No. 2,190,517, and the Swingle patent No. 2,329,362, in suit. Petitioner's commercial breakers, Multi-breaker and Quicklag, bear little or no resemblance to the circuit breaker constructions shown in the drawings and described in the specifications of these patents. (BullDog Appendix, Volume I, pp. 101-2, 235-40, 249-50, 275-6, 284-5, 345-6.)

Petitioner's Multi-breaker and Quicklag breakers, sales of which petitioner relies upon for alleged commercial

success of the patents in suit, are covered by other patents not asserted in this suit to be infringed by respondent (BullDog Appendix, Volume I, pp. 101-4, 236).

Petitioner has granted licenses under its patents for the manufacture of Multi-breakers and Quicklag breakers, and that such of those licenses as are in evidence here contain a large number of circuit breaker patents other than the patents asserted in this suit to be infringed (Ex. 59?, pp. 1-10, 11-16, 12-17, 31-47).

Respondent's circuit breakers, the Circuit Master and the Pushmatic, are substantially different in construction and arrangement of parts from the circuit breakers shown in the drawings and described in the specifications of the patents charged to be infringed (BullDog Appendix, Volume I, pp. 88-91, 158-160, 330-1, 342 and prior testimony beginning at 285).

The Circuit Master and Pushmatic also are substantially different in construction and arrangement of parts from petitioner's commercial breakers, the Multi-breaker and the Quicklag.

Respondent's Circuit Master and Pushmatic do not copy or imitate either the breaker constructions shown in the drawings and described in the specifications of the patents in suit, or petitioner's commercial breakers, the Multi-breaker or the Quicklag.

The detailed findings of the District Court with respect to the Hodgkins Patent No. 2,073,103 appear in the Westinghouse Appendix, pp. 278-289; those with respect to the Jennings Patent No. 2,190,517 appear at pages 289-315; and those with respect to the Swingle Patent No. 2,329,362 at pages 329-341.

After reviewing the prior art, considering the claims of the patents in suit alleged to be infringed in their relation

to the structures disclosed in the patents in suit, the prior art and respondent's circuit breakers alleged to infringe, the District Court concluded (District Court conclusions 2 and 3, Westinghouse Appendix pp. 357-358) that none of the patents in suit are pioneer patents entitled to a wide range of equivalents; that all are improvement patents, and are to be construed in the light of their respective specifications and drawings, and of the prior art, and limited substantially to the devices disclosed in their respective specifications and drawings, and also that respondent's circuit breakers, Circuit Master and Pushmatic, are not in any material or substantial respect similar to the devices disclosed in the drawings and specifications of the patents in suit; and that the drawings and specifications of those patents fail to suggest the construction of respondent's circuit breakers; and that none of the patents in suit are entitled to any range of equivalents that will include respondent's Circuit Master and Pushmatic within their scope; that the claims of those patents asserted to be infringed, when construed in the light of the specifications and drawings of the respective patents in which they are contained and given the meanings there intended, fail to find any response in respondent's circuit breakers.

The District Court's additional conclusions with specific reference to the Hodgkins Patent No. 2,073,103, the Jennings Patent No. 2,190,517, and the Swingle Patent No. 2,329,362, are Nos. 6, 7, 8 and 9 (Westinghouse Appendix, pp. 360-363) and Nos. 13, 14 and 15 (Westinghouse Appendix, pp. 365-367) in which the facts previously found with respect to the validity and alleged infringement of these patents are summarized.

With respect to the Hodgkins Patent No. 2,073,103, the Court of Appeals (Proceedings, Court of Appeals, 4th Circ., pp. 685-6) in affirming the District Court stated:

"Here again we have, at best, a combination patent in a crowded field. All of the important elements in Hodgkins, performing substantially the same functions, may clearly be found in the prior art cited by the District Judge, especially Laganke, No. 1,789,183. And particularly germane are the three cases cited by him in this connection. Indeed, all that Hodgkins accomplished was a rather clever *arrangement* of these elements which possessed some novelty. Manifestly, this patent must be precisely limited to that particular arrangement. As thus limited, all the claims in suit and their specifications fall far short of patentable invention. The Hodgkins patent must, therefore, be declared invalid.

* * *

"We agree with the District Judge that if, under a strict construction of its claims and specifications, the Hodgkins patent should be held valid, it is not infringed by Pushmatic and Circuit Master, the accused devices of BullDog. Counsel for Westinghouse strongly stress in parallel columns of their brief the similarities between Hodgkins, on the one hand, and Pushmatic and Circuit Master on the other. Some of these similarities are inconsequential. Of many more it may truthfully be said that these same similarities may be observed when Hodgkins is compared with the prior art.

"* * * We are also impressed, as was the District Judge, by the testimony of Professor Hoover, BullDog's expert witness, to the effect that there is nothing in the drawings and specifications of the Hodgkins patent that would teach how to design or construct the Circuit Master or the Pushmatic."

With respect to the Jennings Patent No. 2,190,517, the Court of Appeals (Proceedings, Court of Appeals, 4th Circuit, pp. 688-9) in affirming the District Court stated:

"What has been previously said as to the Hodgkins patent seems even truer as to the Jennings patent. Here, again, we find in the prior art all the elements in Jennings, with these elements performing the same functions. This patent, too, is subsequent to Hodgkins and Jackson, No. 2,096,546. All that Jennings has done here is to devise a new arrangement of the old elements, which is, at best a mere nonpatentable aggregation.

"When, as must be the case, the claims and specifications of Jennings are strictly construed, they are not infringed by either Circuit Master or Pushmatic. * * *"

With respect to the Swingle Patent No. 2,329,362, the Court of Appeals (Proceedings, Court of Appeals, 4th Circuit, p. 692) in affirming stated:

"We think the Swingle patent falls in the same category with, and is subject to the same objections as, Hodgkins and Jennings. Once more we find in the prior art all the important elements of Swingle, all performing the same essential functions. The chronology and factual circumstances surrounding its grant seem to strengthen the view that Swingle discloses no more than a mere nonpatentable aggregation.

"Swingle did not originate, and there is nothing new in automatic overload circuit breakers in which all operations are controlled by a single or identical pair of overcenter springs, a so-called 'floating' switch arm operating about two pivot points, a circuit breaker having two main movable members, a handle, and a switch arm having a movable contact rigidly mounted upon it and operated by a single overcenter spring in both manual and overload operations."

The claims in issue of the patents in suit are worded in vague and general terms. The other claims of those patents

directed to the specific improvement disclosed in the drawings and specifications were never charged to be infringed and are not in issue.

There is no conflict in the decisions of Courts of Appeal respecting validity or infringement of the Swingle Patent No. 2,329,362. This patent was not at issue in the case of *Westinghouse v. Frank Adam Electric Co., post,* in the 8th Circuit.

With respect to the alleged conflict between Courts of Appeal regarding the validity of the Hodgkins Patent No. 2,073,103 and the Jennings Patent No. 2,190,517, it appears clearly in the opinion of the Court of Appeals for the 8th Circuit in *Westinghouse Electric & Mfg. Co. v. Frank Adam Electric Co.,* 146 F. (2d) 165, that the judgment of the District Court holding the Hodgkins patent valid and infringed and Jennings valid but not infringed was not reviewed or considered by the Court of Appeals. That Court vacated the judgment and remanded the case to the District Court with instructions to take evidence on the issue of unclean hands arising out of alleged misuse of the patents. The record in the case at bar does not disclose that the judgment of the District Court in the *Westinghouse v. Adam* case was ever reinstated. It is conceded by petitioner that the case was settled between the parties after remand. The record of the case at bar does not disclose the circuit breaker construction found to infringe the Hodgkins patent nor what claims of either the Hodgkins patent or the Jennings patent were found valid or infringed by the District Court in Missouri, nor the considerations upon which such findings were made.

## V. ARGUMENT

### There is no Conflict of Decision Between Courts of Appeal for Different Circuits With Respect to the Validity or Infringement of the Hodgkins Patent or the Jennings Patent

The Court of Appeals for the 8th Circuit did not consider or pass upon or render decision with respect to the validity or infringement of either of those patents. It is clear from its opinion, 146 F (2d) 165, that there can be no inference whatever that it upheld the validity or infringement of those patents, in the face of the fact that it vacated the judgment of the District Court holding such patents valid.

As a matter of interest, the Court of Appeals for the 8th Circuit three months later in a different case, *Frank Adam Electric Co. v. Colt's Patent Fire Arms Mfg. Co.*, 148 F. (2d) 497, in reversing the District Court and holding invalid for want of invention other patents in the circuit breaker art contemporaneous with those in the case at bar, found (p. 500) the circuit breaker art crowded almost to the point of suffocation.

It is apparent that petitioner's ground for certiorari based upon conflict of decisions of different Courts of Appeal is without foundation, and that its argument that the Court of Appeals for the 8th Circuit accepted by logical inference the District Court judgment of validity which it vacated, is without foundation or support in the record.

**The Decision of the Court Below is not in Conflict With the Applicable Decisions of This Court Regarding (a) Construction of Patent Claims, (b) What Constitutes Patentable Invention, and (c) Priority of Invention Between Rival Inventors**

The petitioner avers that the Court of Appeals ignored the wording of the claims and held that there is no infringement because of mere differences of form which are not specified in the claims, and that this makes a nullity of these claims and is contrary to the cited decisions of this Court.

The Courts below have not ignored the wording of the claims in issue of the patents in suit. Those claims are couched in broad, general and vague terms, susceptible of broad or narrow interpretation depending upon the facts found with respect to the nature and extent of invention disclosed in the drawings and specifications of the patents when assessed in comparison with and in the light of the prior art.

The Courts below found the nature and extent of the alleged inventions of the patents over and in view of the prior art to be very narrow and limited, and in considering the question of infringement construed the vague and general terms of the claims accordingly. It gave those terms the meaning required when applied to the specific constructions disclosed in the drawings and specifications of the patents in which they are contained, and so construed found them not to cover or be infringed by the substantially different constructions and arrangements of respondent's circuit breakers.

In this the Courts below did not come in conflict with applicable decisions of this Court. In a leading decision of this Court in *Eibel Process Co. v. Minnesota & Ontario*

*Paper Co.*, 261 U. S. 45, 63, this Court defined the principles to be observed in administering the Patent Law and stated:

> "In administering the Patent Law the court first looks into the art, to find what the real merit of the alleged discovery or invention is, and whether it has advanced the art substantially; and if it has done so, the court is liberal in its construction of the patent to secure to the inventor the reward he deserves.
>
> "If what a patentee has done works only a slight step forward, and that which he says is a discovery is on the borderline between mere mechanical change and real invention, the patent, if sustained, will be given narrow scope, and infringement will be found only in approximate copies of the new device."

In the case at bar the Courts below found as a matter of fact that the patents contained little if any invention over the prior art and accordingly gave them a narrow scope and refused to find infringement by respondent's breakers which were substantially different from and found not to be approximate copies of the breakers disclosed in the patents.

This is not in conflict with decisions of this Court referred to in the petition as the nature and extent of the inventions of the patents here in suit are found to be of little, if any merit, while the nature and extent of the inventions of the patents involved in the cases cited by petitioner were found to be of substantial merit.

Petitioner quotes the decision of this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U. S. 605-607, in that part of the opinion which states that if the accused matter falls clearly within the words of the claim,

infringement is made out and that is the end of it, and that imitation of a patented invention which does not copy every literal detail does not avoid infringement.

The part of that opinion quoted by petitioner is not applicable in the case at bar for the reason that in the cited case the Courts below in concurring decisions had found substantial and meritorious invention over the prior art in the patent involved.

In the case at bar the Courts below have concurred in finding that there is no such invention in the claims in issue of the patents in suit.

Furthermore, petitioner in its reliance upon the *Graver v. Linde* case, ignores the fact that the decision, at page 609, recognizes the established rule stated and applied in *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, to the effect that infringement is not made out even though the accused device corresponds with the letter of the claims of the patent asserted to be infringed where the accused device is so far changed in principle from the patented article that it performs the same or similar function in a substantially different way, but nevertheless falls within the literal words of the claim.

The Courts below in the case at bar have concurred in finding that respondent's accused circuit breakers are so different from the circuit breakers shown in the drawings and disclosed in the specifications of the patents in suit that they do not infringe even though they might be brought within the vague and general terminology of the claims asserted, as petitioner endeavored to do.

Petitioner's argument that it is error to limit the claims in issues of the Swingle patent to a device having two operating springs on the ground that the second spring is essential to the operative structure disclosed in the

drawings and specification of the patent, in view of the decision of this Court in *Deering v. Winona Harvester Works,* 155 U. S. 286, 302, takes no account of the fact that in *Deering v. Winona* (p. 302) the device described by the claim there involved was a pivotal extension to a butt-adjuster newly invented by the patentee and required only conventional means to carrry out its operation, while in the case at bar the Courts below have concurred in finding not only that Swingle did not disclose invention of a device that would operate with a single spring, but also that circuit breakers of the same character operated by a single overcenter spring were old in the art, that Swingle was not entitled in view of the art to predicate invention upon that feature, and that respondent's circuit breaker followed the constructions of the prior art and not that of Swingle.

Petitioner's argument that the decision of the Court of Appeals that the claims in issue of Hodgkins, Jennings and Swingle are invalid for want of patentable invention is contrary to the principles announced by this Court in the decisions cited in the petition, is in error in that it fails to recognize that in the cases cited the Court found the inventions involved to have substantially advanced the art, whereas in the case at bar the Courts below have concurred in finding that the patents in suit have not substantially advanced the art and are but slightly different arrangements of old devices and that respondent has not copied or imitated these arrangements in its circuit breakers.

As stated before (pp. 10-11) in the very decision of *Eibel Process Co. v. Minnesota & Ontario Paper Co.,* 261 U. S. 45, upon which petitioner relies, the Court stated that where the discovery of the patent is on the borderline between mere mechanical change and real invention the

patent, if sustained, will be given a narrow scope and infringement found only in approximate copies of the device.

In the case at bar the Courts below have concurred in finding as fact little or no invention in the claims in issue of the patents in suit in view of the prior art.

Petitioner's contention that the holding that the Jennings patent in suit is anticipated by the work of Christensen is contrary to decision of this Court in *Marconi Wireless Telegraph Co. v. United States,* 320 U. S. 1, 34, holding that one who was the first to conceive and did not abandon his invention is the prior inventor, ignores the fact that the Courts below concurred in the holding that Jennings is not shown by any corroborated evidence to have conceived the invention involved in October, 1935, as petitioner states, or prior to June 5, 1936, which was after conception and reduction to practice of the invention by Christensen. (District Court findings, Westinghouse Appendix, pp. 297-299; District Court conclusions Nos. 8 and 9, Westinghouse Appendix, pp. 362-363; Evidence, BullDog Appendix, Volume III; Westinghouse Appendix, pp. 101-123).

**The Scope and Validity of the Hodgkins, Jennings and Swingle Patents are Not of Great Importance**

Petitioner's argument that the scope and validity of the Hodgkins, Jennings and Swingle patents are of great importance because of the large volume of business involved, the number of licensees under the patents, and the deterrent effect of existing uncertainty upon further development of the circuit breaker industry, is unfounded and without support in the record.

It is conceded that no circuit breakers of the construction shown in the drawings and described in the specifi-

cations of these patents have ever been produced commercially by either petitioner or its licensees. It is conceded that petitioner's commercial breakers, the Multi-breaker and Quicklag, alleged to be made under these patents, are covered by other patents not involved in this suit, and that the licenses under which these commercial breakers are made by others include a large number of other patents which are not here involved. (Statement, p. 3-4.)

There is no evidence in the record establishing that the large volume of business in Multi-breaker and Quicklag circuit breakers is due to the patents in suit, rather than to other patents covering those breakers which are not in suit.

In these circumstances commercial success of the Multi-breaker and the Quicklag cannot be attributed to the patents in suit or the circuit breaker constructions disclosed therein, nor can those patents rightly be said to be of great commercial importance.

> *Murray-Ohio Manufacturing Co. v. E. C. Brown Co.*, 124 F. (2d) 426, 428, (C. C. A. 6);
> *Leahman Co. of America v. Kroll Brothers Co.*, 139 F. (2d) 391, 393 (C. C. A. 7);
> *DeCew v. Union Bag and Paper Corp.*, 57 Fed. Supp. 388, 399-400 (D. C. N. J.).

There is nothing in the decisions of the Courts below which prevents or precludes the manufacture of circuit breakers by the industry, or which prevents or precludes petitioner from making new developments or inventions in circuit breakers, or which prevents or precludes petitioner from selling or any in the industry from taking licenses under petitioner's patents if they so desire.

## VI. CONCLUSIONS

For the foregoing reasons it is respectfully submitted that the petition for writ of certiorari should be denied.

Respectfully submitted,

ARTHUR W. DICKEY,
S. EUGENE BYCHINSKY,
*Counsel for Respondent.*

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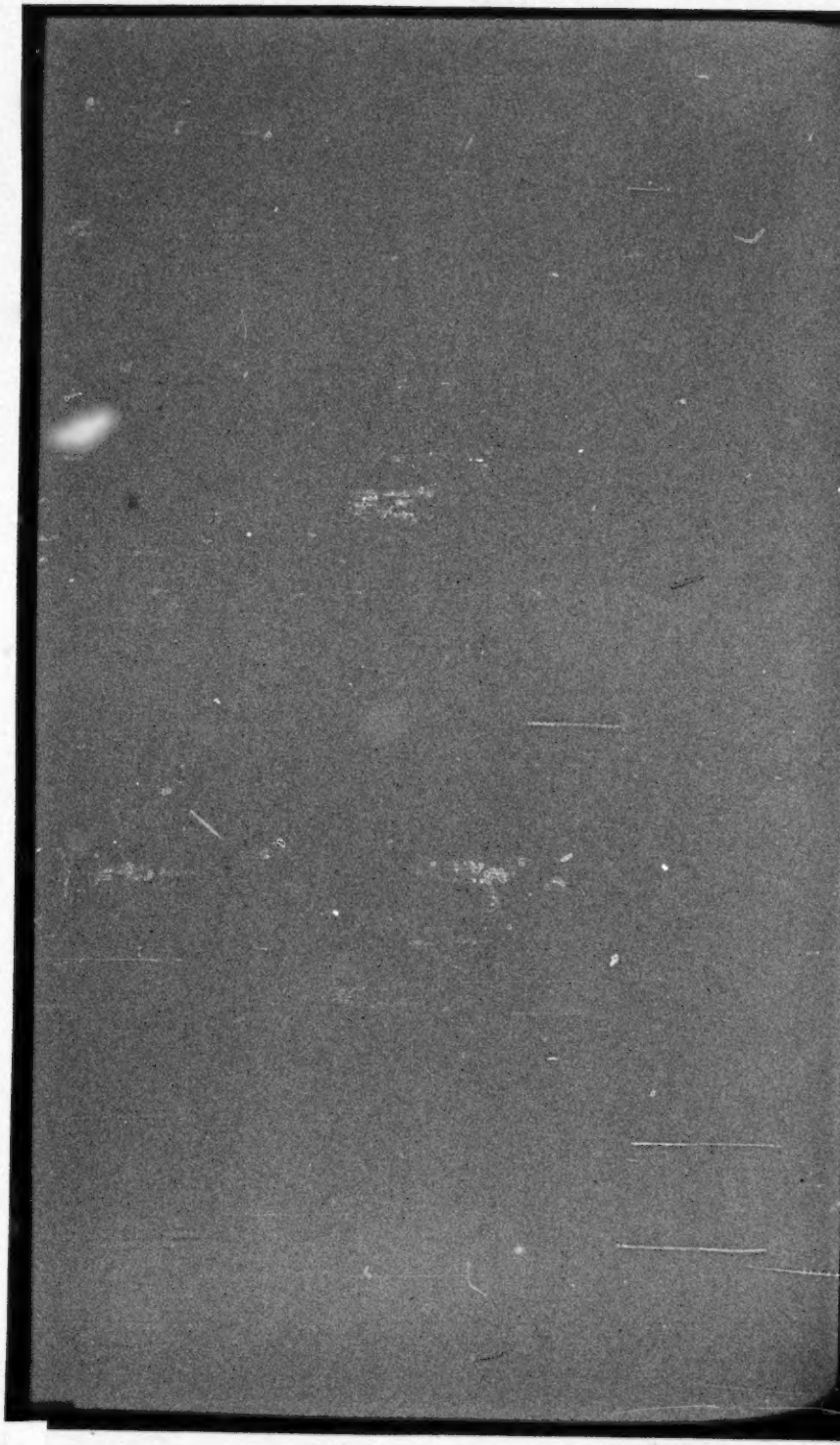
CARL S. LLOYD,
33 N. La Salle St.,
Chicago, Ill.

JAMES M. GUTHRIE,
Union Bank Bldg.,
Clarksburg, W. Va.

RALPH H. SWINDLE,
700 Braddock Ave.,
East Pittsburgh, Pa.

*Attorneys for Petitioner*

TWENTIETH CENTURY PRESS, INC., CHICAGO



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